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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/641,021-Conf. #4559	
	Filing Date	August 17, 2000	
	First Named Inventor	Alan B. Cayton	
	Art Unit	3629	
	Examiner Name	J. P. Ouellette	
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Transmittal

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(Gail Miller)



Docket No.: 59428/P001US/10020580
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Alan B. Cayton et al.

Application No.: 09/641,021

Confirmation No.: 4559

Filed: August 17, 2000

Art Unit: 3629

For: SYSTEM AND METHOD FOR AUTOMATED
SCREENING AND QUALIFICATION OF
EMPLOYMENT CANDIDATES

Examiner: J. P. Ouellette

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.41(a)(1), this Reply Brief is filed within two months of the Examiner's Answer dated July 21, 2005, and is in furtherance of the Appeal Brief filed on May 2, 2006.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

- I. Status of Claims
- II. Ground of Rejection to be Reviewed on Appeal
- III. Argument
- IV. Conclusion

I. STATUS OF CLAIMS

The status of claims remains as identified in the Appeal Brief of May 2, 2006.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection remains as identified in the Appeal Brief of May 2, 2006.

III. ARGUMENT

Appellant respectfully traverses the outstanding claim rejections and requests that the Board reverse those rejections in light of the remarks presented in the Appeal Brief of May 2, 2006. Appellant hereby reasserts those arguments that are presented for the separately argued claims in the Appeal Brief of May 2, 2006. Because the rejections raised in the Examiner's Answer are the same in substance as those raised in the Final Office Action of January 19, 2006, Appellant submits that the Appeal Brief of May 2, 2006 fully addresses those rejections. Thus, for brevity Appellant does not repeat the arguments detailed in the Appeal Brief of May 2, 2006 herein, but instead provides an overview of the arguments below for the Board's convenience, with the full reasoning of the arguments provided in the Appeal Brief of May 2, 2006.

A. Rejections under 35 U.S.C. §102(e) over *Williams*

Claims 1-2, 6-26, 28-34, 36-44, 46-76, and 78-87 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Williams*.

Appellant submits that *Williams* fails to anticipate claims 1-2, 6-26, 28-34, 36-44, 46-76, and 78-87 because: 1) *Williams* is not prior art to these claims in view of the Declaration of Alan Cayton submitted April 6, 2005 (hereinafter "Cayton Declaration") which antedates the July 20, 2000 date of *Williams*, and 2) *Williams* fails to teach all elements of the claims.

1. Cayton Declaration Antedates *Williams*

Applicant submitted the Cayton Declaration April 6, 2005 under 35 C.F.R. §1.131, which sets forth facts sufficient for antedating *Williams*. *Williams* has an effective date under 35 U.S.C. §102(e) of July 20, 2000. The Cayton Declaration establishes prior conception

coupled with diligence to the filing date of the present application less than one month later on August 17, 2000. Thus, the Cayton Declaration antedates *Williams*, and all claim rejections based on *Williams* should therefore fall for at least this reason.

The Examiner's Answer maintains that the declaration filed April 6, 2005 is ineffective for antedating the July 20, 2000 date of *Williams*, see pages 18-20 of the Examiner's Answer. The Examiner's Answer asserts that the declaration of April 6, 2005 is ineffective because: 1) the evidence of conception submitted therewith is insufficient, and 2) the declaration fails to establish sufficient diligence from just prior to the antedated date of July 20, 2000 to the August 17, 2000 filing date of the present application.

Appellant respectfully submits that for the reasons detailed in the Appeal Brief of May 2, 2006 and summarized below, the Cayton Declaration submitted April 6, 2005 is effective for antedating *Williams*.

i. Sufficiency of Evidence of Conception of Invention

The evidence submitted with the Cayton Declaration is sufficient to support the assertion that the claimed invention was conceived prior to July 20, 2000. As set forth in M.P.E.P. § 715.07, conception is the mental part of the inventive act, but it must be capable of proof, as by drawings. *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897) established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. The evidence submitted in the Cayton Declaration is sufficient to establish conception by the inventors prior to July 20, 2000, as discussed further below.

Exhibit A to the Cayton Declaration includes FIGURES, which correspond to FIGURE 1 of the present application. The Cayton Declaration sets forth that Alan Cayton comprehended an embodiment of this invention, as described more fully in conjunction with FIGURE 1 of the present application, prior to June 12, 2000. It should be noted that evidence of actual reduction to practice is not required. Rather, the evidence submitted in the Cayton Declaration (i.e., possession of FIGURE 1 of the present application) is sufficient to give rise to an inference that the invention was conceived prior to June 12, 2000, and thus prior to July 20, 2000, particularly considering that the inventor declares that he had conceived of the

details set forth for this FIGURE in the present application prior to June 12, 2000. Further, considering that the application was filed less than one month after July 20, 2000 (i.e., on August 17, 2000), the fact that FIGURE 1 existed prior to July 20, 2000 supports the assertion that the inventors had, prior to July 20, 2000, conceived of the details discussed with FIGURE 1 in the present application.

Further, the FIGURES included in the evidence are not a “mere vague idea” of how to solve a problem, but instead identify the elements and illustrate interaction between the elements, as discussed further in the May 2, 2006 Appeal Brief.

Further, to dispose of a reference, an applicant need only establish prior conception of as much of the claimed invention as the reference happens to show. For instance, in *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957), the CCPA concluded:

We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references [sic] happens to show. When he has done that he has disposed of the references....

In the case of a reference, it is fundamental that it is valid only for what it discloses and if the applicant establishes priority with respect to that disclosure, and there is no statutory bar, it is of no effect at all....

The rule [1.131] must be construed in accordance with the rights given to inventors by statute and this excludes a construction permitting the further use of a reference as a ground of rejection after all pertinent subject matter in it has been antedated to Dean satisfaction of the patent office.

In the present case, the evidence submitted with the Cayton Declaration certainly shows at least as much detail as is provided in *Williams*. Indeed, the submitted evidence more clearly sets forth that an application generator generates the applications (e.g., IVR SAQs and Browser SAQs) than does the teaching of *Williams*. *Williams* does not clearly establish that an application generator generates the application to interact with candidates. Indeed, Appellant finds no express teaching in *Williams* that an application generator generates the application to interact with candidates. For instance, while *Williams* mentions “the present system and method accepts changes to a client’s or employer’s employment criteria and implements those changes overnight” (col. 2, lines 38-41 of *Williams*), *Williams* makes no mentions of how an application is created to interact with candidates to test for

such employment criteria (e.g., a code developer could work to manually create the application with which candidates interact, rather than an application generator generating such application).

To the extent that any inference regarding an application generator can be drawn from the teaching of *Williams*, the evidence submitted in the Cayton Declaration clearly establishes priority with respect to so much of the claimed invention as *Williams* teaches. That is, the evidence provides at least as much detail concerning an application generator generating applications with which candidates can interact as does the applied *Williams* reference.

In view of the above, Appellant respectfully submits that the Cayton Declaration and its corresponding evidence is sufficient to establish conception prior to July 20, 2000.

ii. Diligence

The Cayton Declaration also provides sufficient information regarding the activity during the period for which diligence is required to establish such diligence on the part of the applicant. To antedate *Williams*, diligence must be shown from prior to July 20, 2000 until the filing date of the present application, August 17, 2000. As the Cayton Declaration sets forth, the applicant diligently worked toward engaging patent counsel for preparing and filing the present application, discussing the invention with patent counsel, reviewing drafts of the patent application provided by patent counsel, providing timely feedback on the drafts of the patent application to patent counsel, and timely approving the final draft of the patent application and executing the declaration for such patent application and returning such executed declaration to patent counsel for filing of the patent application, which patent counsel timely filed with the USPTO after receiving the executed declaration. All of these actions were appropriate steps for diligently pursuing protection of the invention.

The actions detailed in the Cayton Declaration illustrate that Applicant diligently pursued preparation and filing of the present patent application from prior to July 20, 2000 until its filing less than one month later on August 17, 2000.

To be considered diligent, the inventor must generally make a conscious effort to reduce the invention to practice. Here, the inventors were making a conscious effort to constructively reduce the invention to practice through the filing of a patent application.

The Examiner's Answer maintains that the Cayton Declaration fails to establish diligence, asserting that "Applicant must account for the entire period during which diligence is required." Page 19 of the Answer. Applicant respectfully submits that the Cayton Declaration does account for the entire period during which diligence is required. Applicant respectfully notes that short gaps in working toward a reduction to practice during the critical period will not generally negate a finding of diligence. *Mycogen Plant Sci. Inc. v. Monsanto Co.*, 252 F.3d 1306, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001), *petition for cert. filed*, 70 U.S.L.W. 3374 (Nov. 12, 2001). Proof of reasonable diligence does not require a party to work constantly on the invention or to drop all other work. *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986); *In re Nelson*, 420 F.2d 1079, 1081, 164 USPQ 458, 459 (C.C.P.A. 1970); *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (C.C.P.A. 1966). An inventor is not required to rush or take the most efficient development strategy to reduce the invention to practice. *See Justus v. Appenzeller*, 177 USPQ 332, 340 (Pat. Off. Bd. Int. 1971).

Short intervals of inactivity in the preparation, review, and filing of a patent application are generally excused. While the Examiner's Answer notes an extreme case in which a 2-day period lacking activity has been held to be fatal (*see* pages 19-20 of the Examiner's Answer), this is not the general rule. Indeed, intervals greater than those in the present application have been held to be reasonable, and thus not destroy the establishment of diligence. For instance, a two-day lapse between the executing of an application and mailing to the Patent Office, as well as a lapse of approximately two weeks for the inventors to review the application, has been held to fall within the limits of reasonable delay, *see Slettinger v. Lincoln*, 410 F.2d 808, 161 USPQ 725, 728-29 (C.C.P.A. 1969). A 16-day delay between completion of the drawings and specification and the applicant's review and execution of the application was held by the CCPA to be reasonable. *Walker v. Bailey*, 245 F.2d 486, 114 USPQ 302, 304-05 (C.C.P.A. 1957). A delay of four weeks by one joint inventor to review a patent application was held excusable where the other joint inventor was on vacation for three weeks and was unavailable for another week because of an unexpected illness of a parent. *Reed v. Tornqvist*, 436 F.2d 501, 168 USPQ 462, 465 (C.C.P.A. 1971).

In the present case, the applicant diligently sought patent protection without delays as great as those found acceptable in the above exemplary cases. For instance, prior to July 20,

2000, the applicant's actively sought and obtained patent counsel for the express purpose of constructively reducing the invention to practice (through the filing of a patent application). The applicant engaged Fulbright as its patent counsel on June 22, 2000, and a draft of the application was prepared and sent to the inventors for their review on July 28, 2000. The application was reviewed, finalized and filed on August 17, 2000.

Therefore, Applicant respectfully submits that the above activity set forth in the Cayton Declaration is sufficient to establish diligence on the part of the applicant during the period for which such diligence is required.

In view of the above, the Cayton Declaration is sufficient to antedate *Williams*, and therefore all rejections based on *Williams* should be overturned. For example, the rejection of independent claim 1 as being anticipated by *Williams* should be overturned.

2. *Williams* Fails to Teach All Claim Elements

To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see* M.P.E.P. § 2131. *Williams* fails to teach every element of the independent claims, as well as the further elements of various dependent claims, as explained in detail in the Appeal Brief of May 2, 2006.

For instance, *Williams* does not teach a computer program "generating at least one customized application program that is executable to interact with candidates", as recited by claim 1. While *Williams* mentions receiving an employer's hiring criteria and using an application program to interact with candidates to screen the candidates against the employer's hiring criteria, *Williams* provides no express teaching that the application program with which the candidates interact is generated by another computer program. Rather, in *Williams*, such application program could be generated through manual coding by a developer. Again, no express or inherent teaching of a computer program generating the application program with which candidates then interact is present in *Williams*.

While *Williams* describes a system with which a candidate interacts to perform qualification, *Williams* provides no teaching whatsoever of a computer program that generates an application program with which the candidate interacts, as discussed further in the Appeal Brief of May 2, 2006. Rather, the application program(s) with which the

candidates interact in *Williams* may be manually coded by software developers, for example, instead of being generated by a computer program.

Accordingly, *Williams* fails to teach all element of independent claim 1, and thus fails to anticipate claim 1 under 35 U.S.C. § 102. Therefore, the rejection of claim 1 should be overturned for this further reason.

Further reasoning as to why the rejections of the current claims should be overturned is provided in detail in the May 2, 2006 Appeal Brief, which Appellant respectfully requests the Board to consider in full in response to the Examiner's Answer.

IV. CONCLUSION

Appellant respectfully requests that the Board overturn the rejections of pending claims 1-92 for the reasons detailed in the May 2, 2006 Appeal Brief.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 568241025US in an envelope addressed to: M/S Appeal Brief-Patents, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: August 15, 2006

Typed Name: Gail L. Miller

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Respectfully submitted,

By: 

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